

REMARKS

Reconsideration and allowance are respectfully requested.

Remarks Regarding Claim Amendments:

The claim amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry. Entry of the claim amendments is requested.

Remarks Regarding Section 112:

The Patent Office has the initial burden to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04, and the cases cited therein. It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi*, 169 USPQ 367, 370 (C.C.P.A. 1971). Specific technical reasons are always required. See M.P.E.P. § 2164.04.

Claims 1-15 stand rejected under 35 U.S.C. § 112 first paragraph as allegedly non-enabling. Applicants traverse. Specifically, the office action asserts that while the specification enable making compounds of Formula III with a catalyst of structure VIIa or VIIb, it does not reasonably provide enablement for the process using a catalyst of the structure VIIc. Solely in an effort to expedite prosecution, and not addressing the merits of the Examiner's argument, Applicants have amended the claims to remove recitations to structure VIIc. Since the allegedly non-enabled catalyst is removed, this rejection is now moot. Withdrawal of the enablement rejection made under Section 112, first paragraph, is requested because it would not require undue experimentation for a person of skill in the art to make and use the claimed invention.

Remarks Regarding Section 103:

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d

1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See *id.* (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”). The use of hindsight reasoning is impermissible. See *id.* at 1397 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”). Thus, a *prima facie* case of obviousness requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn* at 1335; see *KSR* at 1396. An inquiry is required as to “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1396. But a claim directed to a combination of prior art elements “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.*

Claims 18 and 19 stand rejected under 35 U.S.C. §103 as allegedly obvious in view of Imfeld (U.S. Patent 4,689,427). Applicants traverse. Specifically, the Office Action alleged that while Imfeld does not specifically teach the chemical structures claimed in claims 18 and 19, one of ordinary skill in the art using esters would have a reasonable expectation of success for making Applicants’ claimed chemical structures from Imfeld’s structures.

Applicants note that almost every chemical structure known to man was made by a combination of known substructures such as methyl groups, alkenyl groups, esters etc. Taken to the extreme, every chemical structure is a combination of specific atoms known and disclosed in the Periodic Table. Applicants invention, in this case, is the non-obvious choice of chemical structures which, when joined, form a novel and useful chemical structure. Once Applicants’ claimed structure is disclosed, one of skill in the art, using the teachings of the Specification, can synthesize the structure using known chemical synthesis methods.

Imfeld does not render obvious the structures of claims 18 and 19. In this case, Imfeld refers to hydroquinone derivatives useful as intermediates for the manufacture of (R,R,R)- α -tocopherol as well as of racemic α -tocopherol. While Imfeld refers to multiple chemicals in its specification, and while Imfeld was under an obligation to disclose its best mode to the USPTO, Imfeld neither disclosed nor suggested Applicants' claimed structure. Therefore, there is no motivation for one of skill in the art, on reading Imfeld, to produce Applicants' claimed structures.

Further, Imfeld teaches against the use or synthesis of Applicants' claimed structure because the cited reference disclosed the best mode for practicing the Imfeld's invention without disclosing Applicants' claimed structure. One of skill in the art, upon reading Imfeld, would be motivated to synthesize the disclosed structures comprising its best mode for practicing its invention. Further, since Imfeld did not disclose Applicants' claimed structures, one of skill in the art would realize that Applicants' claimed structures would not be the best mode for practicing Imfeld's invention. For this reason, Imfeld teaches against the Applicants' claimed structures by showing other structures satisfy the best mode requirement of the USPTO.

Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinary skill in the art when this invention was made.

Remarks Regarding Double Patenting:

Claims 18-19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 18 and 19 of copending Application 10/571,252. Applicants traverse because a terminal disclaimer may be submitted or conflicting claims 18 and 19 of Application 10/571,252 may be canceled upon an indication of allowable subject matter. To require submission of a terminal disclaimer prior to an indication that the claims are otherwise allowable would constitute an undue burden on Applicants because no allowable subject matter in either application has been indicated by the Patent Office.

Remarks Regarding Allowable Claims:

Applicants note, with appreciation, that the Examiner has indicated that claims 16 and 17 are found to be allowable.

Conclusion

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if additional information is required.

Respectfully submitted,

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